

R E M A R K S

Claims 1-24 are pending and at issue.

Filed concurrently herewith is an Information Disclosure Statement disclosing the prior art that has been submitted or cited in co-pending application Serial No. 10/271,464 to McDonald which has been relied on this current Office Action as Publication No. US 2004/0074936 A1. The Information Disclosure Statement includes photographs of a soft-sided cooler that is described in detail in the Background section of the McDonald application and which was on sale more than one year before the filing date of the present application. This soft-sided cooler differs from that disclosed in the McDonald application with respect to the tab features on the quick access opening. The Examiner's attention is brought to this soft-sided cooler.

The rejections based on the McDonald reference are traversed because the McDonald reference is disqualified as a prior art reference under 35 U.S.C. §103(c) because the subject matter disclosed in the McDonald application and the claimed invention were at the time the claimed invention made, subject to an obligation of Assignment to Thermos L.L.C., as shown by the Assignments recorded at Reel 013481, Reel 0267; Reel 013495, Reel 0799; and Reel 014985, Frame 0409. Accordingly, the rejections based on McDonald should be withdrawn.

Notwithstanding the above, the rejections are also traversed because they are based upon an improper modification of a soft-sided cooler such as disclosed in the McDonald application, and even if the modification were made, the references relied on in the Office Action fail to suggest the claimed invention.

More specifically, all of the rejections are based upon a modification of a soft-sided cooler such as disclosed in McDonald with the teaching of Weimer US 2003/0168371 A1. The Office Action asserts that it would be obvious to one of ordinary skill in the art to provide the cooler of McDonald with a decorative figure as disclosed in Weimer. However, there is nothing in either McDonald or Weimer which discloses or suggests that a rigid, sculpted decorative lid such as disclosed in Weimer would be appropriate for use in a soft-sided cooler such as disclosed in McDonald. Indeed, the rigid, sculpted lid of Weimer would make a soft-sided cooler, such as disclosed in McDonald, unsuitable for its intended purpose because it would make the cooler rigid, thereby not allowing for the desired collapsibility that is provided by soft-sided coolers. (See ¶3 of McDonald.) This is not allowed. See MPEP §2143.01 stating that "the proposed modification cannot render the prior art unsatisfactory for its intended purpose." Accordingly, for this reason alone, the rejection should be withdrawn.

Furthermore, even if one were to modify a soft-sided cooler such as disclosed in McDonald with the sculpted lids of Weimer, one would not arrive at the claimed invention because Weimer fails to disclose a flap that defines part of a decora-

tive figure that is formed on a top panel or lid when such a flap is connected to the top panel or lid to be movable between positions opening and closing a quick access opening, such as recited in the rejected claims. In short, Weimer simply suggests having a lid with decorative features, but fails to suggest that a flap carried by the lid should form part of the decorative features. The Office Action attempts to overcome the shortcomings of Weimer by characterizing the lid 26 as "a secondary closure 26", when in fact there is nothing in Weimer to support a characterization of the lid 26 (14a) as a "secondary" closure rather than a "primary" closure. Both of the lid portions 14a and 14b in Weimer are connected to the body of the rigid cooler, and neither of the lid portions 14a and 14b are carried or mounted to a lid. Thus, Weimer suggests nothing with respect to a flap carried by a lid, such as disclosed in McDonald. Accordingly, one can only arrive at the claimed invention with the benefit of hindsight after having reviewed the present invention. For this additional reason alone, the rejections are improper and should be withdrawn.

Additionally, with respect to the rejection of claims 3, 7, 15, 18 and 21, the Office Action proposes a further modification of McDonald and Weimer with the teaching of Hodge 5,842,900. However, this proposed modification is improper because the Hodge reference is nonanalogous art that one skilled in the cooler art would not look to in seeking to make an improvement. Specifically, Hodge is directed towards a stuffed doll or toy that carries a picture frame hidden by a decorative panel. A person skilled in the cooler art would simply not look to such an apparatus when

seeking to make an improvement in coolers, absent hindsight direction from reading the present application. In this regard, it is important that the basic structure of the Hodge device is itself a decorative figure because it is a stuffed doll or toy and would not be relevant or pertinent to one seeking to provide decorative features to a practical article, such as a soft-sided cooler. Thus, it cannot fairly be argued that a decorative panel used to hide a picture frame that has been mounted within the body of a stuffed doll or toy is reasonably pertinent to providing a decorative figure on a flap that allows access to the interior of a storage area of a soft-sided cooler. Accordingly, for this additional reason, the rejections of claims 3, 7, 15, 18 and 21 are improper.

Additionally, as with Weimer, Hodge fails to suggest anything with respect to a flap that is carried by a lid, let alone when such a flap is used to define part of a decorative feature of the lid. Accordingly, Hodge teaches nothing with respect to an opening tab of such a flap. Accordingly, the reliance in the rejection on Hodge for this feature is improper. The rejection should be withdrawn for this additional reason alone.

Furthermore, specifically with respect to claims 7 and 18, Hodge fails to disclose that the opening tab defines a portion of the decorative figure that includes a tooth or a lip of an animal or a grill of a car, as recited in claims 7 and 18. Accordingly, for this additional reason alone, the rejection of claims 7 and 18 should be withdrawn.

With respect to the rejection of claims 8, 20 and 24, the Office Action proposes to further modify McDonald and Weimer with the disclosure of Dege et al 6,688,570 by adding the lid 28 of Dege et al and its rectangular-shaped envelope 48 carried thereon to a soft-sided cooler such as disclosed in McDonald. However, the envelope 48 of Dege et al is accessed via an internal opening 50, rather than a quick access opening in the lid. Accordingly, Dege et al does not disclose or suggest a storage compartment as recited in the rejected claims. Thus, even if one were to make the proposed modification, one would not arrive at the subject matter recited in the rejected claims. Accordingly, for this additional reason alone, the rejection is improper and should be withdrawn.

Additionally, the rejection is improper because the addition of the envelope 48 would overcome the very purpose of the quick access opening in a soft-sided cooler such as taught in McDonald by preventing access to the interior of the soft-sided cooler. Accordingly, for this additional reason alone, the reaction is improper and should be withdrawn.

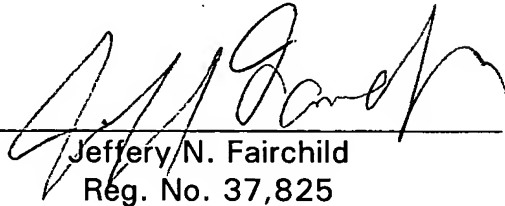
Finally, the first page of the Office Action indicated that claim 23 is rejected, but there is no stated formal grounds of rejection in the Office Action. Accordingly, the status of claim 23 is indeterminate based on the Office Action. Clarification is requested.

In view of the foregoing, Applicant respectfully request reconsideration
of the rejections and allowance of the case.

Respectfully submitted,

WOOD, PHILLIPS, KATZ,
CLARK & MORTIMER

By



Jeffery N. Fairchild
Reg. No. 37,825

January 20, 2005

500 West Madison Street
Suite 3800
Chicago, IL 60661-2511
(312) 876-1800